

STATEMENT OF SUBSTANCE OF INTERVIEW

Applicants would like to express appreciation to Examiners Dunn and Pritchett for the personal interview of January 12, 2006 with Applicants' Representative, Attorney William Boshnick. During the interview, Applicants' Representative initially discussed the various limitations of claim 1 that are neither taught nor suggested by the applied references, for example that since YAMAZAKI does not have at least the claimed reticle, this reference cannot (in any proper combination with KOBAYASHI) teach or suggest at least wherein a measured dioptric power difference between a first dioptric power of a combination of an eye of the user and an ocular lens system of said observation optical system, focusing on said reticle, and a second dioptric power of a combination of the eye and said ocular lens system and an objective lens system of said observation optical system, focusing on an object to be observed, is cancelled. The Examiner indicated that a "reticle" is very common in the art, and that it would be obvious to include this feature in the invention, to which Applicants Representative responded by requesting that the Examiner provide support for such an assertion in a subsequent official action.

Regarding the "new matter" rejection under 35 U.S.C. § 112, first paragraph, the Examiners maintained that the newly-added definition of the "theoretical position" in claim 1 is not sufficiently described in the specification, since "theoretical position" is mentioned only once (*i.e.*, page 37). Applicants' Representative pointed out that the "theoretical position" (as described on page 37) is the position determined by the cam groove in Fig. 9, and that there is significant description of the claimed structures associated with Fig. 9 beginning, *e.g.*, page 28, line 5 – page 30, line 18, to reasonably convey to one skilled in the art that the inventors, at the time the application was filed,

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had possession of the claimed invention. The Examiners remained unconvinced, and suggested an appeal or pre-appeal conference.

REMARKS

Applicants would like to express appreciation to the Examiner for the detailed Official Action provided. Upon entry of the present paper, claim 1 will have been amended, with claims 1-8 remaining pending before the Examiner. Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate.

The Examiner has objected to the drawings, requiring that “the focusing of light to define the theoretical position as stated in claim 1 must be shown or the features(s) canceled from the claim(s).”

Applicants respectfully traverse the Examiner’s objection, in that Fig. 9 already shows the theoretical position as recited in the claims. Specifically, Applicants note that the specification (at, e.g., page 28, line 12 – page 30, line 18) sufficiently describes the structure of the cam grooves of Fig. 9 in relation to the focusing of the photographing optical system and observation optical system so that one skilled in the art would understand the theoretical position as defined in the claims. Applicants submit that it is thus unnecessary to show the “focusing of light” in the figures to define the theoretical position of claim 1.

Nevertheless, to further the Examiner’s understanding that one skilled in the art would understand the theoretical position as defined in the claims, Applicants submit herewith Attachment 1 (showing Figs. A, B and C). In Fig. A, the theoretical position is shown. In other words, the image observed through the observation optical system (the upper optical system in Fig. A) is focused on the reticle, and the image obtained by the photographic optical system (the upper optical system in Fig. A) is also focused on the CCD. It is noted that the cam groove 75 of Fig. 9 is shown

in Fig. A.

Fig. B shows the image observed through the observation optical system focused on a plane that is at the rear side (*i.e.*, toward the image side) of the reticle, and the image obtained by the photographic optical system is focused on the rear side of (*i.e.*, beyond) the CCD, and is out of focus. A clear image thus cannot be obtained. For example, at close range, when a user focuses the image using a device having the cam groove 75 of Fig. 9 (*i.e.*, the device of Figs. A and B), the photographing optical system will be out of focus (*i.e.*, there will be an amount of defocus), while the image viewed through the observation optical system by the user will appear to be in focus to the user (due in part to the phenomenon of “instrument myopia,” described in Applicant’s specification at *inter alia*, beginning page 4, line 15). Thus, the image viewed through the observation optical system will be focused on a plane that is toward the image side of the reticle (*i.e.*, to the right side when viewing Fig. B). This phenomenon is further described in Applicant’s specification at *inter alia*, beginning page 30, line 3. The result of this error is that photographic images captured with the device of Fig. B will be out of focus.

Fig. C shows a non-limiting feature of the claimed invention, namely, at close range, when the user focuses the observation optical system to suit his or her individual dioptric power (resulting in the viewed image being focused on a plane that is toward the image side of the reticle), the image obtained through the photographing optical system will be focused on the plane of the CCD (contrary to the device of Fig. B, in which the image will be focused beyond the plane of the CCD). This advantage is due to the design of the cam groove 75 of Fig. 13 (shown in Fig. C), which counteracts a user’s “instrument myopia” by causing the photographing optical system to be positioned closer to

the object side than at the theoretical position (shown in Fig. C in hatched lines).

Thus, Applicants respectfully request that the Examiner withdraw the objection to the drawings.

The Examiner has rejected claims 1-8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the Examiner's rejection, and note, for at least the reasons discussed *supra*, that the subject matter of claims 1-8 is indeed sufficiently described in the specification to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. To facilitate the Examiner's understanding of the same, the Examiner is again invited to review Attachment 1 and the above description in view of the specification. Applicants further respectfully disagree with the Examiner's determination that the drawings and the specification never show any relation between the theoretical position and the focusing of light on certain elements. To the contrary, Applicants' specification, beginning, *inter alia*, page 27, line 7 describes, the helicoid cam grooves of Fig. 9 and how they associate movement between the pair of telescopic optical systems 12R and 12L and the photographing optical system 68. Further, the reticle 78 for focusing light is described in detail in Applicants' specification beginning, *inter alia*, page 30, line 19. It is thus respectfully requested that the Examiner withdraw this rejection.

The Examiner has objected to claims 1-8, noting that the top portions of the cam grooves 75 of both Fig. 9 and Fig. 13 are at the same location, and that therefore the photographing optical system and the theoretical position are at the same location, and is not positioned at an object side in relation to the theoretical position. Applicant notes that the top of the cam groove 75 of Fig. 13 is

coincident with the top of the cam groove 75 of Fig. 9 (the theoretical position), and that this top area corresponds to infinity. The lower part of the cam groove 75 (*i.e.*, the part immediately below the top of the cam groove 75) corresponds to a close range view, which in Fig. 13 is offset from the cam groove 75 of Fig. 9. Thus, when an image is viewed at close range (*i.e.*, at a near focusing distance), the photographing optical system is positioned at an object side, in relation to the theoretical position (shown in broken lines in Fig. 13). This feature is described, *inter alia*, beginning page 29, line 14 of Applicants' specification. Without agreeing to the propriety of the Examiner's objection, Applicants have amended independent claim 1 to clarify that "said second focusing mechanism being constructed in such a manner that, when an object contained in said close-range view is observed, the photographing optical system is positioned at an object side, in relation to a theoretical position determined when the photographing optical system focuses on an object, when said observation optical system focuses on the object." It is thus respectfully requested that the Examiner withdraw the objection to the claims.

The Examiner has rejected of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,067,027 to YAMAZAKI in view of JP 10-239735 to KOBAYASHI. Specifically, the Examiner has found that YAMAZAKI teaches all of the claimed limitations except (with respect to claim 1) that YAMAZAKI "lacks specific reference to the dioptric power difference between the eye and the ocular lens system and the objective lens system and the observation optical system being cancelled," but has found that KOBAYASHI teaches such a limitation, and concluded that it would have been obvious to combine the device of KOBAYASHI with the system of YAMAZAKI.

Applicants respectfully traverse the Examiner's rejection, and expressly incorporate herein

the arguments proffered in Applicants' previous responses. Initially, Applicants note that (as proffered in Applicants' previous responses) YAMAZAKI fails to teach or suggest the claimed reticle; rather, the "reticle" 11 of YAMAZAKI identified by the Examiner is merely the objective lens system. Applicants further note that KOBAYASHI also fails to disclose such a reticle. Rather, KOBAYASHI discloses a viewfinder of a camera, and *does not* operate in association with the photographic optical system. KOBAYASHI merely discloses that the diopter is set to a constant minus value regardless of the object distance, so that the image viewed through the viewfinder remains in focus to the user when the finder is moved between short and far distances, and *does not* suggest at least that the second focusing mechanism being constructed in such a manner that, when an object contained in said close-range view is observed, the photographing optical system is positioned at an object side, in relation to a theoretical position determined when the photographing optical system focuses on an object, when said observation optical system focuses on the object, wherein a measured dioptric power difference between a first dioptric power of a combination of an eye of the user and an ocular lens system of said observation optical system, focusing on said reticle, and a second dioptric power of a combination of the eye and said ocular lens system and an objective lens system of said observation optical system, focusing on an object to be observed, is cancelled, as claimed in claim 1.

Thus, contrary to the Examiner's determination, YAMAZAKI and KOBAYASHI, in any proper combination, *do not* include all of the structural or functional limitations of the claimed invention, and neither teaches or suggests the present claimed invention.

With respect to the Examiner's rejection of dependent claims 2-8, since these claims are

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dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Thus, Applicants respectfully submit that each and every pending claim of the present application meets the requirements for Patentability at least under 35 U.S.C. §§ 103 and 112, and respectfully request the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the fact that none of the art of record, whether considered alone, or in any proper combination thereof, discloses or suggests the present invention, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. The amendment to the claim has not been made for a purpose related to patentability, but rather is a clarifying amendment that is cosmetic in nature by rendering explicit what was already implied in these claims, *i.e.*, said second focusing mechanism being constructed in such a manner that, when an object contained in said close-range view is observed, the photographing optical system is positioned at an object side, in relation to a theoretical position determined when the photographing optical system focuses on an object, when said observation optical system focuses on the object. The amendment to the claim should thus be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. Accordingly, this amendment should not be considered a decision by Applicants to narrow the claims in any way.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Masami SHIRAI et al.

William Boshnick

William S. Boshnick
Reg. No. 44,550

Bruce H. Bernstein
Reg. No. 29,027

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191